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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,676	04/09/2001	Steven V. Kauffman	SVL920010029US1	1588

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EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,676

Applicant(s)

KAUFFMAN ET AL.

Examiner

HELEN SHIBRU

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The RCE, filed on 07/24/2006, have been entered and made of record. Claims 1-27 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection. See the new ground(s) of rejection sets forth below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1- 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (US Pat. No. 5237648) in view of Koyata (US Pat. No. 6,462,753).

Regarding claim 1, Mills discloses a method for specifying a selection of content segments stored in different formats, comprising the steps of:
receiving specification of a plurality of portions (see fig. 2 clip edit window (22)) of first content; (video frame (36)) stored in a first format (see fig. 2 in video window (20), and col. 4 lines 29-46),
the specification identifying beginning and ending frames for each portion (see col. 4 lines 29-54); and
building a list comprising a starting mark and ending mark for each selected portion of first content, the list for use in accessing corresponding portions of the same content stored as second format (see fig.2 clip edit (22) in a second format; edit window (38) and col. 4 line 59-col. 5 line 7).

Claim 1 differs from Mills in that the claim further requires the first content is stored in a first storage medium and the second content is stored in a second storage medium wherein the second storage medium is a slower access storage medium than the first storage medium.

In the same field of endeavor Koyata discloses an editing operation on selected programs. Koyata further discloses a first window, a second window and a third window are displayed on the display unit, and when the user performs the drag and drop operation he or she can select a CD and a program to be recorded to the MD recorder (see col. 6 lines 13-21 and fig. 3). Koyata further discloses a magnetic tape, a DVD, CD-R, an MO, or a semiconductor memory can be used as an alternative (see col. 16 lines 28-37). Koyata further discloses designating a desired

program on the first content list and move it to the second content list in order to record it in the second recording medium from the first recording medium (see claim 12). Therefore in light of the teaching in Koyata, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record the second content to the second recording medium in order to record the desired content in the second recording medium.

Regarding claim 2, Mills discloses the starting mark and ending mark further comprise frame numbers (it is inherent that the begin and end frames have numbers, see col. 6 lines 12-18).

Regarding claim 8, the examiner read claim 8 as the second content has a second format different than the first format. Mills discloses the second content has a second format different than the first format (it is inherent that the frames in clip edit window (22) have different resolution than frames in video frame (36) see col. 4 lines 35-46).

6. Claims 3-7, 11-15, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills in view of Koyata and further in view of Fujita (US Pat. No. 6321024).

Regarding claims 3 and 4, claims 3 and 4 differ from Mills and Koyata in that the claims further require the step of converting the starting mark and ending mark into timecodes, and the first content includes timecodes superimposed on its frames further comprising the step of first determining a correspondence between frame numbers and timecodes of the first content and using the determined correspondence to convert the starting mark and ending mark into timecodes. Mills does not disclose the step of converting the starting mark and ending mark into timecodes, however, Mills disclose the user has the ability to create new points using frame numbers (see col. 1 lines 45-53).

In the same field of endeavor, Fujita discloses the first content includes timecodes superimposed on its frames (see col. 8 lines 22-32). Fujita further discloses the starting mark and ending mark are converted into timecodes (see col. 11 lines 49-60). Therefore, in light of the teaching in Fujita it would have been obvious to one of ordinary skill in the art to modify Mills as modified by Koyata by converting starting and ending to timecodes and to superimpose timecodes on its frames in order to display the frame in a time form.

Regarding claim 5, claim 5 differs from Mills and Koyata in that the claim further requires the starting mark and the ending mark further comprise timecodes. Mills does not disclose the starting mark and the ending mark comprise timecodes, however, Mills discloses begin and end points are created using small digitized frames (SDF) (see col. 2 lines 24-44).

In the same field of endeavor, Fujita discloses the starting mark (see fig. 3 in frame (317)) and the ending mark (see fig. 3 out frame (319)) further comprise timecodes (see fig. 3 frame number display box (318) and (320) and col. 13 lines 3-10). Fujita further discloses frame numbers or timecodes are allocated to the frames of the video images (see col. 8 lines 22-32). Therefore in light of the teaching in Fujita, it would have been obvious to one of ordinary skill in the art to modify Mills as modified by Koyata by providing timecodes for starting and ending marks in order to associate timecodes corresponding to the frames (see col. 9 lines 11-19).

Regarding claim 6, Fujita discloses the timecodes are extracted from the first content (see col. 12 lines 16-18 and col. 9 lines 11-19).

Claim 7 is rejected for the same reason as discussed in claim 4 above.

Claims 11, 12, 15, 19, 20 and 23 are rejected for the same reason as discussed in method claims 3 and 4 above.

Claims 13 and 21 are rejected for the same reason as discussed in method claim 5 above.

Claims 14 and 22 are rejected for the same reason as discussed in method claim 6 above.

7. Claims 9-10, 16-18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills in view of Koyata and further in view of Official Notice.

Regarding claims 9-10, 16-18, and 24 the limitations in these claims can be found in the method claims 1-2, and 8. However claims 9-10, 16-18, and 24 further requires a program product containing instructions causing the computer to execute steps as claimed in claims 1-2, and 8. Official Notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Mills as modified by Koyata by having a program product of being read by a computer tangibly embodying a program causing the computer to execute the steps of the method claims. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

8. Claims 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mills in view of Koyata and further in view of Langford (US Pat. No. 5,206,929).

Regarding claim 25, Claim 25 differs from the proposed combination of Mills and Koyata in that the claim further requires a starting mark and an end mark in the list to calculate an offset into content stored in the second storage medium and using the calculated offset to retrieve the second content from the second storage unit. Although Mills and Koyata does not specifically teach the limitation of claim 25, Mills teaches

In the same field of endeavor Langford discloses an edit list having six edit windows (see fig. 12). Langford further discloses the 'in' and 'out' frame time codes of the tape or video disk from which the edit was chosen are displayed (see col. 13 lines 6-10). Langford further discloses the duration of the edit found and displayed in display area 415 in fig. 12 (see col. 13 lines 10-14). Therefore in light of the teaching in Langford it would have been obvious to modify Mills as further modified by Koyata by providing offset to retrieve the second content in order to specify the desired transition.

9. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills in view of Koyata and further in view of Official Notice and further in view of Langford.

The limitation of claims 26-27 can be found in claim 25. Therefore claims 26-27 are analyzed and rejected for the same reason as discussed in claim 25 above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chao et al. (US Pat. No. 5,732,184)

Peters et al. (US Pat. No. 5,930,445)

Chen et al. (US Pat. No. 6,600,869)

Eubanks et al. (US Pat. No. 6,944,390).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru
August 3, 2006



THAI Q. TRAN
PRIMARY EXAMINER